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**REMARKS**

Reconsideration and allowance are requested. The Examiner rejected pending claims 1 - 94. Claims 1, 31, 57, 68 and 86 are amended.

**Rejection of Claims 1 - 13, 17 - 20, 23 - 24, 31 - 35, 38 - 42, 44 - 46, 49 - 50, 57 - 59, 61, 68 - 72, 76 - 69 and 81 Under Section 102**

The Examiner rejects claims 1 - 13, 17 - 20, 23 - 24, 31 - 35, 38 - 42, 44 - 46, 49 - 50, 57 - 59, 61, 68 - 72, 76 - 69 and 81 under Section 102 as being anticipated by U.S. Patent No. 6,035,273 to Spies ("Spies"). Applicants submit that the claims as amended are patentable over the Spies reference.

Claim 1 recites a method for converting text to speech including the step of receiving data representing a textual message, the message being originally created by the author as a text message and being directed from the author to the recipient. The limitation that the author originally creates the message as a text message is not taught nor suggested by Spies. Notably, Spies even teaches away from such a feature.

Spies addressed a deficiency in the art as he identified wherein the bandwidth for telephone communications was narrow and there was an increasing need for bandwidth to transmit video and other data in addition to telephone speech. See col. 1. The need Spies was addressing was in the context of one person talking with another in a telephone conversation. The purpose of his invention was to provide the ability in such a conversation to convert the speech signal into text for transmission via a small number of bits whereupon at the recipient compression and transmission device (CTD) the text is converted back into speech to be heard by the recipient. In this respect, Spies does not teach that one participant in this communication creates an original text message. Spies teaches that each participant in the communication speaks when "creating" the messages that are exchanged. Note that each of Figures 1, 2 and 3 of Spies requires the author to "speak" the original message as part of a telephone conversation. In contrast to the teachings of Spies, when the author of the message

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creates a text message for transmission as is recited in claim 1, the same bandwidth problems simply do not exist as do in telephone conversations.

Therefore, Applicants submit that claim 1 is not taught by Spies and in fact Spies teaches away from one of the participants to the conversation creating a text message for a recipient. Such a component is counter to the fundamental principle of operation of Spies and important to his invention addressing the deficiency in the art of telecommunications he identifies. Therefore, Applicants submit that claim 1 is patentable over Spies and in condition for allowance.

Claims 2 - 13, 17 - 20 and 23 - 24 each depend from claim 1 and recite further limitations therefrom. Therefore Applicants submit that these claims are patentable as well over Spies.

Claim 31 is amended to recite a text to speech conversion system that includes program code that converts text data representing a textual message created as a text message by an author and directed to a recipient. The arguments set forth above for claim 1 equally support the allowability of claim 31. Spies does not teach that an original text message is converted to speech data. Therefore, Applicants submit that claim 31 is patentable and in condition for allowance.

Claims 32 - 35, 38 - 42, 44 - 46 and 49 - 50 each depend from claim 31 and recite further limitations therefrom. Accordingly, Applicants submit that these claims are patentable as well.

Claim 57 is amended to recite a text to speech conversion system including means for receiving a textual message created as a text message by the author and directed to a recipient. As mentioned above, such a feature is not taught by Spies and therefore, Applicants submit that claim 57 is patentable and in condition for allowance.

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Claims 58 - 59, 61, 68 - 72, 76 - 69 and 81 each depend from claim 57 and recite further limitations therefrom. Accordingly, Applicants submit that these claims are patentable as well.

**Rejection of Claims 14 - 16, 21 - 22, 36 - 37, 43, 47 - 48, 60, 73 - 75, 80, 86 - 89, 90 and 93 Under Section 103**

The Examiner rejected claims 14 - 16, 21 - 22, 36 - 37, 43, 47 - 48, 60, 73 - 75, 80, 86 - 89, 90 and 93 under Section 103 in view of Spies and U.S. Patent No. 5,812,126 to Richardson ("Richardson"). Applicants traverse this rejection and submit that no motivation or suggestion exist to combine Spies with Richardson.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification of the prior art would change the principle operation of the prior art invention being modified, then the teaching of the reference is not sufficient to

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render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The principles outlined in both these cases are applicable here.

The Examiner states that Spies fails to teach the first computer and the second computer being configured to communicate in an instant messaging format. However, the Examiner asserts that it would be obvious to one of skill in the art to modify the system of Spies to implement the Richardson text-to-speech system in an instant messaging format, to allow users of the Internet in a hands-busy or eyes-busy environment. Applicants respectfully submit, however, that modifying Spies so as to make it possible to blend in the teachings of Richardson would require changing the principle operation of Spies such that it would clearly not be obvious to combine these references.

As is stated in the title of the Spies reference, his focus is on "speaker-specific speech-to-text/text-to-speech communication." Spies' system includes a compression and transmission device (CTD) at each end of a conversation. This enables both individuals in the conversation to speak and have their speech converted to text, transmitted, and then via the text-to-speech component with the speaker's voice profile, reproduced for the listener. As he explains in his introduction, the Spies reference focuses on the problems with low data rates in telephone conversations. The purpose of his invention is to provide an improved communication system for compressions and transmitting speech. FIG. 1 of Spies shows the CTD 2 for one person in the conversation and CTD 4 for the other person in a conversation. FIG. 2 explains the method aspect of the invention wherein the connection between the first and second CTD (step 203) provides for the exchange of speech profiles (204) and the conversion of speech to text and transmission from the speaker to the listener's CTD, and then converted back to speech using the voice characteristics of the speaker. FIG. 3 is similar to FIG. 1 in that it shows two CTD's 40, 44.

Thus, the purpose and focus of the Spies reference is to provide the speech-to-text conversion, transmission of text (low bandwidth instead of high bandwidth transmission), and

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then the text-to-speech conversion in a telephone conversation. If one were to modify Spies to change it to an instant messaging format, that change would require abandoning the fundamental principle of operation of Spies, namely, operating in the context of a telephone conversation. In other words, by altering one of the CTD's in a telephone conversation to a computer with an instant messaging capability, this removes the need for one person in the 'conversation' to speak. One who performs instant messaging types comments rather than speaks. This eliminates one CTD from each of Figures 1 and 3 and many of the steps of Figure 2 of Spies.

Further, given the purpose of Spies, Applicants submit that there is nothing in Spies that would provide motivation or a suggestion to one of skill in the art to eliminate a CTD from its disclosure and replace that CTD with a device which enables the user to type in a message. Such a change would be counterproductive to the purpose and intent of the Spies invention.

Applicants submit that modifying Spies to remove a CTD from the system would simply render the Spies invention meaningless for its intended purpose. Such a modified device would no longer provide an improved system for low bandwidth telephone communication.

Further, as noted above with regards to the Section 102 rejection, Applicants note that the independent claims rejected above are not taught by Spies. For these reasons, Applicants submit that claims 14 - 16, 21 - 22, 36 - 37, 43, 47 - 48, 60, 73 - 75, 80, 86 - 89, 90 and 93 are patentable because Spies does not teach each limitation of the parent independent claims and further for the reason that Spies cannot be legally combined with Richardson. Applicants respectfully requests allowance of these claims.

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**CONCLUSION**

Having addressed the rejection of claims 1 - 94, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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By: Thomas M. Isaacson

Correspondence Address:  
Samuel H. Dworetzky  
AT&T Corp.  
Room 2A-207  
One AT&T Way  
Bedminster, NJ 07921

Thomas M. Isaacson  
Attorney for Applicants  
Reg. No. 44,166  
Phone: 410-414-3056  
Fax No.: 410-510-1433